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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,597	03/12/2004	Brian Barnes	60655.6200	2596
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FITZPATRICK CELLA HARPER & SCINTO			LE, UYEN CHAU N	
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DATE MAILED: 03/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

A

Office Action Summary	Application No. 10/708,597	Applicant(s) BARNES ET AL.	
	Examiner Uyen-Chau N. Le	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/04; 8/04; 4/05; 5/05</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2876

DETAILED ACTION

Prelim. Amdt/Amendment

1. Receipt is acknowledged of the Preliminary Amendment filed 14 June 2006.

Specification

2. The abstract of the disclosure is objected to because of its informalities.

Re abstract, line 6: Substitute "resource"s" with -- resource's --.

Correction is required. See MPEP § 608.01(b).

Claim Objections

3. Claims 1-2 and 9 are objected to because of the following informalities:

Re claim 1, line 4: Delete ", said transponder system identifier"

Re claim 2, line 4: Substitute "method" with -- computer-implemented device --.

Re claim 9, line 4: Delete ", said transponder system identifier"

Art Unit: 2876

Re claim 9, line 6: Substitute "interface" with -- interface; -

Re claim 9, line 9: Substitute "interface." with -- interface;

Appropriate correction is required.

Provisional Obviousness-Type Double Patenting

4. Claims 1-8, 13 and 22-26 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 and 10-15 of copending Application No. 10/883,458 (hereinafter '458).

Re claims 1-8: Although the conflicting claims are not identical, they are not patentably distinct from each other because in claims 1-8 of the instant application, Applicants claim a system for performance tracking transponder, the system comprising "a **transponder system** responsive to a **Radio Frequency interrogation signal**", "... storing at least a **transponder system identifier**"; "a **Radio Frequency Identification (RFID) reader** in Radio Frequency (RF) communication with said transponder system, said RFID reader **providing said interrogation signal** to said transponder system and **receiving said transponder system identifier**"; and "a **resource engine** associated with an **employer identifier**, said resource engine including a **point of interaction terminal**, said point of interaction

Art Unit: 2876

terminal in communication with said RFID reader; wherein said RFID reader provides said transponder system identifier to said point of interaction terminal, said point of interaction terminal associating said employer identifier and transponder system identifier to a resource transaction request, forming a performance tracking request, said point of interaction terminal providing said performance tracking request to a resource engine server". The '458 patent discloses a system for facilitating a transaction comprising "a transponder system responsive to a Radio Frequency (RF) interrogation signal, said transponder system operable to provide an account number via RF communication..."; "a RF reader in RF communication with said transponder system, said RF reader operable to provide an interrogation signal to said transponder system and receive said account number via RF communication; "a resource engine associated with an employer identifier, said resource engine including a point of interaction terminal, said point of interaction terminal in communication with said RF reader; wherein said RF reader provides said account number to said point of interaction terminal, said point of interaction terminal associating said employer identifier and said account number to a resource transaction request, forming a performance tracking request, said point of interaction terminal providing said performance tracking request to a resource engine server." Although the scope of claims

Art Unit: 2876

1-8 of the present application and claims 1-8 of '458 application are almost identical, the difference between the present claimed invention and the '458 application is that the present claimed invention is a broader recitation of the '458 application (e.g., the present claimed invention recites "**RFID reader** providing said **interrogation signal** to said transponder system and **receiving said transponder system identifier**, etc." whereby the '149 application recites "**RF reader** operable to **provide an interrogation signal** to said transponder system and **receive said account number** via RF communication, etc."). Thus, with respect to above discussions, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to use the teaching of claims 1-8 of '458 application as a general teaching for having a system for performance tracking with the same functions as claimed by the present application. The instant claims obviously encompass the patented claims and differ only in terminology. To the extent that the instant claim is broaden and therefore generic to the patented claims [species], In re Goodman 29 USPQ 2d 2010 CAFC 1993, states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously been patented.

Re claims 13 and 22-26: Although the conflicting claims are not identical, they are not patentably distinct from each other because in claims 13 and 22-26 of the instant application, Applicants claim

Art Unit: 2876

a method for facilitating performance tracking comprising: using/facilitating "a **transponder** to provide a **transponder account identifier** to a radio frequency identification **reader** via a radio frequency signal"; "associating the transponder account identifier with an **employer account identifier** to form a performance tracking request"; "communicating said performance tracking request to a **point of interaction terminal**"; wherein said point of interaction terminal further communicates with a **resource engine** using said resource engine to **facilitate tracking the performance** of a resource associated with said transponder; and wherein said tracking includes at least one of managing, assigning, tracking and grading at least one of resources, tasks, applications, and skills". The '458 patent discloses a method for **facilitating performance tracking** comprising: method for facilitating performance tracking comprising: using/facilitating "a **transponder** to provide a **transponder account identifier** to a radio frequency identification reader via a radio frequency signal...;" "associating the transponder account identifier with an **employer account identifier** to form a **performance tracking request**;" "communicating said performance tracking request to a **point of interaction terminal**; wherein said point of interaction terminal further communicates with a **resource engine** using said resource engine to facilitate tracking the performance of a resource associated with said transponder; and wherein said tracking

Art Unit: 2876

includes at least one of management, assignment, grading, pricing, checking-out, inventorying, stocking, shipping, scoring, manipulation, tracking, control, and allocation at least one of resources, tasks, shoppers, products, and supplies." Although the scope of claims 13 and 22-26 of the present application and claims 10-15 of '458 application are almost identical, the difference between the present claimed invention and the '458 application is that the present claimed invention is a broader recitation of the '458 application (e.g., the present claimed invention does not recite "transponder operable to provide said account identifier in **ISO/IEC 7816 magnetic stripe Track1/Track 2 format**" as in '458). Thus, with respect to above discussions, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to use the teaching of claims 10-15 of '458 application as a general teaching for having a system for performance tracking with the same functions as claimed by the present application. The instant claims obviously encompass the patented claims and differ only in terminology. To the extent that the instant claim is broaden and therefore generic to the patented claims [species], In re Goodman 29 USPQ 2d 2010 CAFC 1993, states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously been patented.

Art Unit: 2876

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Kolls (US 6853894 B1).

Re claim 1: Kolls discloses a transponder reader performance tracking system comprising a device 200 serves as a transponder

Art Unit: 2876

system responsive to a Radio Frequency interrogation signal, said transponder system including a transponder database, said transponder database storing at least a transponder system identifier (i.e., for identifying a vehicle and/or vehicle's owner account) (figs. 1E & 1N; col. 9, lines 43-54 and col. 14, lines 1-22); a Radio Frequency Identification (RFID) reader (i.e., wireless transceiver 134) associated with a COM device 100, which serves as a resource engine associated with an employer identifier (e.g., SHELL, TEXACO, EXXON, etc.) in Radio Frequency (RF) communication with said transponder system (i.e., device 200) (fig. 3; col. 39, line 50 through col. 40, line 12), said RFID reader providing said interrogation signal to said transponder system and receiving said transponder system identifier (i.e., vehicle's identifier and/or vehicle's owner account) (col. 9, line 30 through col. 10, line 45); said resource engine including a point of interaction terminal (col. 14, lines 60-67), said point of interaction terminal in communication with said RFID reader (fig. 3); wherein said RFID reader provides said transponder system identifier to said point of interaction terminal, said point of interaction terminal associating said employer identifier and transponder system identifier to a resource transaction request, forming a performance tracking request, said point of interaction terminal providing said performance tracking request to a resource engine server (fig. 11;

Art Unit: 2876

col. 10, line 18 through col. 11, line 9; col. 33, line 27 through col. 35, line 39).

Re claim 2: wherein said resource engine includes a computer-implemented device configured to facilitate at least one of the management, assignment, grading, and tracking of at least one of resources, tasks, applications, and skills, said method including: a device configured to facilitate obtaining information on applications problems; a device configured to facilitate the defining of tasks associated with said application problems; a device configured to facilitate a determination of the desired resource skills sets to complete said tasks; and a device configured to facilitate the management of said resource: and tasks, wherein said device includes at least one of: a device configured to facilitate the automatic grading of skills sets of at least one of local and remote resources to determine resource skills sets scores; a device configured to facilitate the automatic assignment of said resources to said tasks based on said desired resource skills sets and said resource skills sets scores, and a device configured to facilitate the automatic tracking of said resources based on task start and completion times (figs. 15A-B & 22; col. 11, lines 1-9; col. 33, lines 27-35; col. 63, line 49 through col. 65, line 56; and col. 72, line 58 through col. 73, line 49).

Art Unit: 2876

Re claim 3: wherein the RFID reader is configured to be at least one of a free standing and a computer-implemented device (figs. 1A, 1D, 1E, 1H, 1J).

Re claim 4: wherein said resource engine further comprises: a device configured to facilitate grading and tracking said resources and said tasks by the use of an algorithm, said algorithm based upon at least one of: the start times for said application tasks, the completion times for said application tasks and comparisons of resource efficiencies relating to application tasks (figs. 15A-B & 22; col. 63, line 49 through col. 65, line 56; and col. 72, line 58 through col. 73, line 49).

Re claim 5: wherein the RFID reader is further configured to with at least one biometric security devices, wherein the biometric security devices include at least one of pre-registration biometric information, a biometric sensor, and current biometric information (col. 14, lines 60-67).

Re claim 6: wherein said biometric information includes at least one of fingerprints, a facial scan, a retinal image, an iris image, a voice print, and a vascular pattern scan (fig. 21; col. 72, lines 5-16).

Re claim 7: wherein said RFID reader is further configured to communicate with at least one third-party merchant systems (i.e.,

Art Unit: 2876

communicating via internet with a plurality of Internet appliances) (figs. 2B & 2C; col. 35, lines 15-38).

Re claim 8: wherein said RFID reader is configured to facilitate at least one of transactions, security, and check-out (e.g., transaction/checkout at tollbooth 330).

Re claim 9: see claims 1, 5 and 6 above.

Re claim 10: said resource engine further comprising universal serial bus interface 156 (fig. 3).

Re claim 11: see claim 7 above

Re claim 12: wherein said RFID reader is further configured with a device to monitor and track locational information (figs. 23-25; col. 35, lines 15-39 and col. 73, line 50 through col. 76, line 47).

Re claims 13, 14 and 16: see claims 1 and 2 above.

Re claim 15: wherein said step of obtaining information related to applications problems further comprises the step of accessing a system for n the management, assignment, grading, and tracking of at least one of resources, tasks, applications, and skills said step of accessing comprises: inputting authentication information including at least one of a name, password, and identification; verifying said authentication information; and transmitting at least one of a homepage and webpage for interfacing with said system (col. 40, lines 13-35).

Re claims 17-18: see claims 5 and 6 above.

Re claim 19: see claim 7 above.

Re claim 20: see claim 8 above.

Re claim 21: wherein said step of communicating further comprises using said communications to facilitate security measures (see abstract).

Re claims 22-26: see claims 1-7 and 12 above.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The patents to Kolls (US 6895310 B1); Barnes et al (US 20050038718 A1); Hanna et al (US 20040016796 A1) are cited as of interest and illustrate a similar structure to method and system for tracking user performance.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 571-272-2397. The examiner can normally be reached on First Monday 5:30AM-1:30PM and Tues-Fri 5:30AM-3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be

Art Unit: 2876

reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Uyen-Chau N. Le
Primary Examiner
Art Unit 2876

March 16, 2006